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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,635

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Tsontcho Ianchulev

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FISH & RICHARDSON PC  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER

STULTZ, JESSICA T

ART UNIT

PAPER NUMBER

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04/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,635	<b>Applicant(s)</b> IANCHULEV, TSONTCHO	
	<b>Examiner</b> Jessica T. Stultz	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-6, and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Norrby et al US 6,609,793, herein referred to as Norrby et al '793.

Regarding claim 1, Norrby et al '793 discloses a method for selecting the power of an intraocular lens (Abstract, Column 4, lines 16-55, Column 5, lines 33-37, and Column 10, lines 17-34), comprising extracting the native lens (Column 11, lines 44-51, wherein the natural lens is removed from the eye); performing auto refraction on the aphakic eye to provide one or more aphakic refraction measurements (Column 8, line 66-Column 9, line 9 and Column 11, lines 44-65, wherein aberrations and refraction measurements, of the aphakic eye are determined automatically); determining the power of the intraocular lens from the one or more aphakic refraction measurements (Column 5, lines 33-37, Column 10, lines 17-34 and Column 11, lines 29-65, wherein the refractive power of the intraocular lens is determined using the aphakic measurements, which include refraction and aberration measurements).

Regarding claim 4, Norrby et al '793 further discloses that the method is used for patients that have previously undergone vision correcting refractive surgery (Column 8, lines 57-65,

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wherein the patients include patients that have previously undergone corrective refractive surgery).

Regarding claims 5-6, Norrby et al '793 further discloses that the determining the power of the intraocular lens comprises using a predictive model that is an empirically or theoretically derived relationship between the auto refraction measurements and the power of the intraocular lens (Abstract and Column 5, line 33-Column 7, line 33, wherein the power of the lens is determined by corneal modeling and Zernike wavefront aberrations, thereby empirical and theoretical models).

Regarding claim 8, Norrby et al '793 further discloses that the auto refraction comprises making a plurality of auto refraction measurements and averaging the measurements (Column 7, lines 13-63).

Regarding claims 9-11, Norrby et al '793 further discloses that the power of the intraocular lens comprises determining the power from the one or more auto refractive measurements and from other parameters (Column 4, line 56-Column 5, line 48), specifically, preoperative (Column 8, lines 57-65, wherein the patients include those about to have surgery, i.e. preoperative) anatomic measurements of the eye (Column 4, lines 61-65) or intraoperative axial length (Column 5, lines 33-48).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norrby et al '793, as applied to independent claim 1 above, and further in view of Sunalp et al US 2004/0167622, herein referred to as Sunalp et al '622.

Regarding claims 2-3 and 7, Norrby et al '793 discloses a method for selecting the power of an intraocular lens as shown above, but does not specifically disclose that the auto refraction is performed with the patient in the same position in which the native lens was extracted, specifically in the supine position or that the native lens is extracted using a surgical microscope and the auto refraction is performed using an auto refraction device configured to be moved into place for making auto refraction measurements following extraction of the native lens using the surgical microscope. In the same field of endeavor of method for selecting power of an intraocular lens, Sunalp et al '622 teaches of measuring the refraction of a post-operative eye while the patient in the same position in which the native lens was extracted, specifically in the supine position (Sections 26-27, Figure 4) wherein the native lens is extracted using a surgical microscope and the auto refraction is performed using an auto refraction device configured to be moved into place for making auto refraction measurements following extraction of the native lens using the surgical microscope (Sections 18 and 24-27) for the purpose of obtaining accurate measurement of the refractive status of an eye and calculate intraocular lens power where keratometry readings are difficult to obtain (Sections 19 and 24). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method for selecting the power of an intraocular lens of Norrby et al '793 to further comprise the auto refraction performed with the patient in the same position in which the native lens was extracted, specifically in the supine position, wherein the native lens is extracted using a surgical

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microscope and the auto refraction is performed using an auto refraction device configured to be moved into place for making auto refraction measurements following extraction of the native lens using the surgical microscope since Sunalp et al '622 teaches of measuring the refraction of a post-operative eye while the patient in the same position in which the native lens was extracted, specifically in the supine position wherein the native lens is extracted using a surgical microscope and the auto refraction is performed using an auto refraction device configured to be moved into place for making auto refraction measurements following extraction of the native lens using the surgical microscope for the purpose of obtaining accurate measurement of the refractive status of an eye and calculate intraocular lens power where keratometry readings are difficult to obtain.

### ***Response to Arguments***

Applicant's arguments filed January 11, 2008 have been fully considered but they are not persuasive. Specifically, regarding independent claim 1, applicant argues that the Norrby reference does not disclose performing intraoperative measurements of the aphakic eye to determine the power of the lens. However, the examiner disagrees since Norrby et al '793 discloses the step of determining the power of the intraocular lens from the one or more aphakic refraction measurements (Column 5, lines 33-37, Column 10, lines 17-34 and, Column 11, lines 29-65, wherein the refractive power of the intraocular lens is determined using the aphakic measurements, which include both refraction and aberration measurements) as shown above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T. Stultz whose telephone number is (571) 272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Jessica T Stultz  
Primary Examiner  
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/Jessica T Stultz/  
Primary Examiner, Art Unit 2873